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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,217	03/02/2004	Akira Yoneoka	P21-163407M/NY	9855
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MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817			EXAMINER MITCHELL, KATHERINE W	
			ART UNIT	PAPER NUMBER
			3677	

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/790,217

Applicant(s)

YONEOKA, AKIRA

Examiner

Katherine W. Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. Applicant has responded to examiner's objections, but has not corrected them, arguing that they are in error. Perhaps it was not clear exactly what the problems were.

Clarifications are in bold. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. **Examples** which are not inclusive of some unclear, inexact or verbose terms used in the specification are:

- Amended paragraph described as beginning on page 6, line 13 has:
 - a reference to "the engagement portions" in lines 6-7, but has disclosed only an engagement portion. **Examiner is saying that this specific embodiment is not clear. Looking at paragraph [0014]:**

A fourth invention provides a jointing member having a grommet and a pin. The grommet includes a flange portion and a leg portion capable of being opened, in which an insertion hole is formed from a center of the flange portion to an inner portion of the leg portion, and **an engagement portion** is formed at an inner surface of the leg portion. The pin includes a head portion and a shaft portion to be inserted into the insertion hole, in which an engagement surface and a lock surface each

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engaging with **the engagement portions** are formed at the shaft portion....

The fourth embodiment is disclosed as having an engagement portion, yet the engagement portions are formed... In the same paragraph, only the engagement portion is displaced. The text should be consistent.

- “the flange portion of the grommet has a large-diameter portion of the insertion hole,... -- what does this mean?
- “whose diameter is small than that...” is incorrect
- “an engagement hole in a position where a bottom portion of the large-diameter portion is adjacent, and an extending portion which is extended to form a pin hole portion whose diameter is small than that of the large-diameter portion in a free state on a side of a tip where it is far from the flange portion,” -- what is “it” – the tip?
- “...displaced to a circumference direction...” is still unclear. What is a circumferential direction -- does this mean the engagement portion (portion should be plural--examiner) is displaced in a radially outward direction? --In a radially outward direction -- is clear, (or radially inward) but how is something displaced to a circumferential direction?
- “...the engagement surface has a lock surface which protrudes in a circumferential direction in a tip of the shaft portion...” is unclear. First, how does a surface has a surface? Examiner assumes --the engagement surface defines a locking surface--,which would be clear. Again, how

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does something protrude in a circumferential direction? There are numerous circumferences in the structure, and as discussed above, a radially outward (or radially inward) direction is clear, but examiner does not know how a circumferential direction is defined.

- *Applicant has amended to :*

“ The engagement portion of the grommet, and the engagement surface of the pin and lock surface are relatively provided in a shaft direction at a position where the grommet and the pin are enabled to slide for a predetermined distance in a state that the grommet and the pin are incorporated so that the leg portion is opened. “

After considerable effort, examiner believes this should be something like:

--The engagement portion of the grommet, and the engagement surface of the pin and lock surface, are located relative to each other in an axial direction on the shaft such that the grommet and the pin are capable of sliding a predetermined distance when the leg portion is opened by the pin location within the grommet opening.--

2. The above is just a detail from 1 re-amended paragraph. The entire specification must be amended to be in clear, concise, and exact English. Failure to do so will result in the next response being held non-responsive.

Drawings

3. In view of the description and clarification in applicants' remarks, the drawing objection is cancelled.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with examples of unclear and imprecise terms, including lack of proper antecedent basis, unclear structural details, and confusing wording. Examples include but are NOT limited to the following:

- Claim 1, the shaft portion of the pin has an engagement surface and a lock surface “at the shaft” each engaging with the engagement portion without positively defining the structure as on or part of the shaft.
- Further, applicant claims in claims 1 and 9 that the shaft is TO BE INSERTED into the insertion hole, and then also recites that “an engagement surface and a lock surface each engaging with the engagement portion...”. If the shaft is not inserted, but to be inserted, how are both the engagement surface and lock surface engaging (not engageable with, but engaging) the engagement portion? Further, even if the pin shaft was already inserted in the insertion hole, how are engagement surface and lock surface EACH ENGAGING the engagement portion--it appears to examiner in the figures that only one of the engagement surface or lock surface can engage the engagement portion at any position or state. This seems impossible based on the described structure.
- Looking at claim 9: the flange portion of the grommet comprises a large diameter portion of the insertion hole...and an extending portion which is extended to form a pinhole portion whose diameter is smaller than that of the

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large diameter portion in a free state on a side of a tip that is far from the flange portion....”

- At least claim 9: What is the meaning of “displaced to a circumferential direction”? There is a circumference of a flange, a tip, a pin, a head, a grommet, a shaft, a leg portion...many things can have a circumference. Does it go in the direction of the plane of the circumference? Is it radially outward? Radially inward? Where is this defined?
- Re claim 2: It is unclear what is meant by “drawing out direction”.

1. Re claim 14: What is a tip end side?

Re claim 17: How does a projection get formed on a slit? A slit is an opening.

The figures show rib walls 12 on pins, so the projection is assumed to be on the grommet. Spec discloses projections 11, shown as recess, not projection. Is

applicant considering a recess to be a --hole projection--, which is contradictory to the accepted meaning of projection. Where applicant acts as his or her own

lexicographer to specifically define a term of a claim contrary to its ordinary

meaning, the written description must clearly redefine the claim term and set

forth the uncommon definition so as to put one reasonably skilled in the art on

notice that the applicant intended to so redefine that claim term. *Process Control*

Corp. v. HydReclaim Corp., 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed.

Cir. 1999). The term is indefinite because the specification does not clearly

redefine the term. Examiner cannot comprehend what applicant is trying to

describe or claim.

Examiner cannot reconcile spec, drawings, and claim 17.

Re claim 18: The grammar of claim 18 requires the slits to be formed on an outer periphery of said shaft portion, which is part of the pin. However, the rib walls are also required to be on the pin, since claim 17 has the projection on the slit engaging the rib wall, and all figures show ribs 12 on the pin. For engagement, the projection and slit must be on different parts - one on the pin, one on the grommet. If the slits are on the pin, and the ribs (shown clearly as 12 on the pin in the figures) are on the pin, how do they engage each other?

Examiner considers claims 17-20 unexamined, as the previous 112 rejection required clarification of all claims.

2. Claims 2-8 and 10-20 are rejected as depending from claims 1 or 9.

Again, these are NON-LIMITING examples only. Claims must be definite and unambiguous. One of ordinary skill with average knowledge of the English language and terminology should be able to read the claims and understand the invention. Applicant needs to completely review each claim and ensure that the claims are clear and definite.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

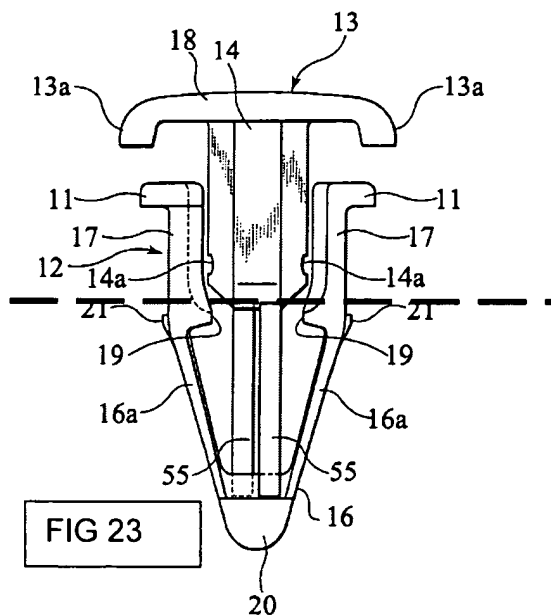
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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11. As best understood by examiner, claims 1- 8 and 12-14, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Arisaka USP 6511273.

Re claim 1: Arisaka teaches a jointing member comprising a grommet 12 and pin 13. The grommet has a flange and leg portions, capable of being opened, and there is an insertion hole in the center of the flange to an inner portion of the leg. There is an engagement portion (19) on the leg portion. The pin includes a head and shaft, said shaft insertable in the insertion hole of the grommet, the shaft has an engagement surface (unnumbered @ 45 degree sloped bottoms just below each of the "14a's" in Fig 23 below) and a lock surface (14a) each engageable with the engagement portion. The distance from the grommet flange to the grommet leg portion tip is greater than a distance from the pin head to the pin tip.



Re claim 2; The pin is axially movable when the grommet engagement portion engages the pin engagement surface.

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Re claims 3,4: The grommet engagement portion engages the pin lock surface when the pin moves along the lock surface while maintaining the leg portion in an open state.

Re claims 5,6,7,8: The tip end of the shaft portion is buried in the grommet insertion hole when the grommet engagement portion engages the pin engagement surface.

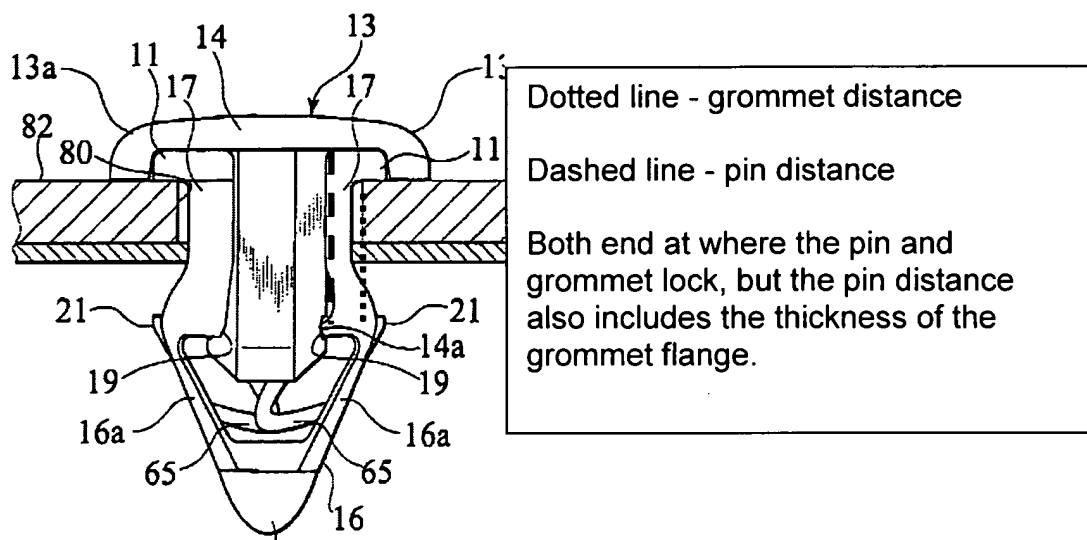
Re claim 12; The engagement portion 19 comprises a protruding portion extending from the leg inner surface.

Re claim 13: There are a plurality of slits (best seen Fig 22 -- between leg portions 16a and 16a, and also having hinges 55 in the slits) in the grommet dividing the leg into a plurality of leg pieces.

Re claim 14: Anything below the dashed line by examiner is considered where an expanded tip end side of the leg begins. Note that Fig 29 shows how this section expands when inserted. The engagement portion is formed on the inner surface of this tip end side.

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Re claim 21: The distance from the grommet flange to the grommet engagement portion is smaller than the distance from the pinhead to the pin lock surface (best seen



in Fig 29:

3. As best understood by examiner, claims 1- 8 and 12-14, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by LeVey USP 6045309.

Re claim 1; Similar to the rejection above, LeVey teaches jointing member comprising a grommet 14 and pin 12. The grommet has a flange and leg portions, capable of being opened, and there is an insertion hole in the center of the flange to an inner portion of the leg. There is an engagement portion (75,76, Fig 9 and 10, col 4 lines 34-53) on the leg portion. The pin includes a head and shaft, said shaft insertable in the insertion hole of the grommet, the shaft has an engagement surface (40 to 46 below) and a lock surface (at 48,50) each engageable with the engagement portion. The distance from the grommet flange to the grommet leg portion tip is greater than a distance from the pin head to the pin tip.

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Re claim 2; The pin is axially movable when the grommet engagement portion engages the pin engagement surface.

Re claims 3,4: The grommet engagement portion engages the pin lock surface when the pin moves along the lock surface while maintaining the leg portion in an open state.

Re claims 5,6,7,8: The tip end of the shaft portion is buried in the grommet insertion hole when the grommet engagement portion engages the pin engagement surface.

Re claim 12; The engagement portion comprises a protruding portion extending from the leg inner surface - see Fig 1 and 9.

Re claim 13: There are a plurality of slits (best seen Fig 1 -- between leg portions 77,78, in the grommet dividing the leg into a plurality of leg pieces.

Re claim 14: Anything below the dashed line by examiner is considered where an expanded tip end side of the leg begins. Note that Fig 9 shows how this section expands when inserted. The engagement portion is formed on the inner surface of this tip end side.

Re claim 21: The distance from the grommet flange to the grommet engagement portion is smaller than the distance from the pinhead to the pin lock surface (best seen in Fig 9)

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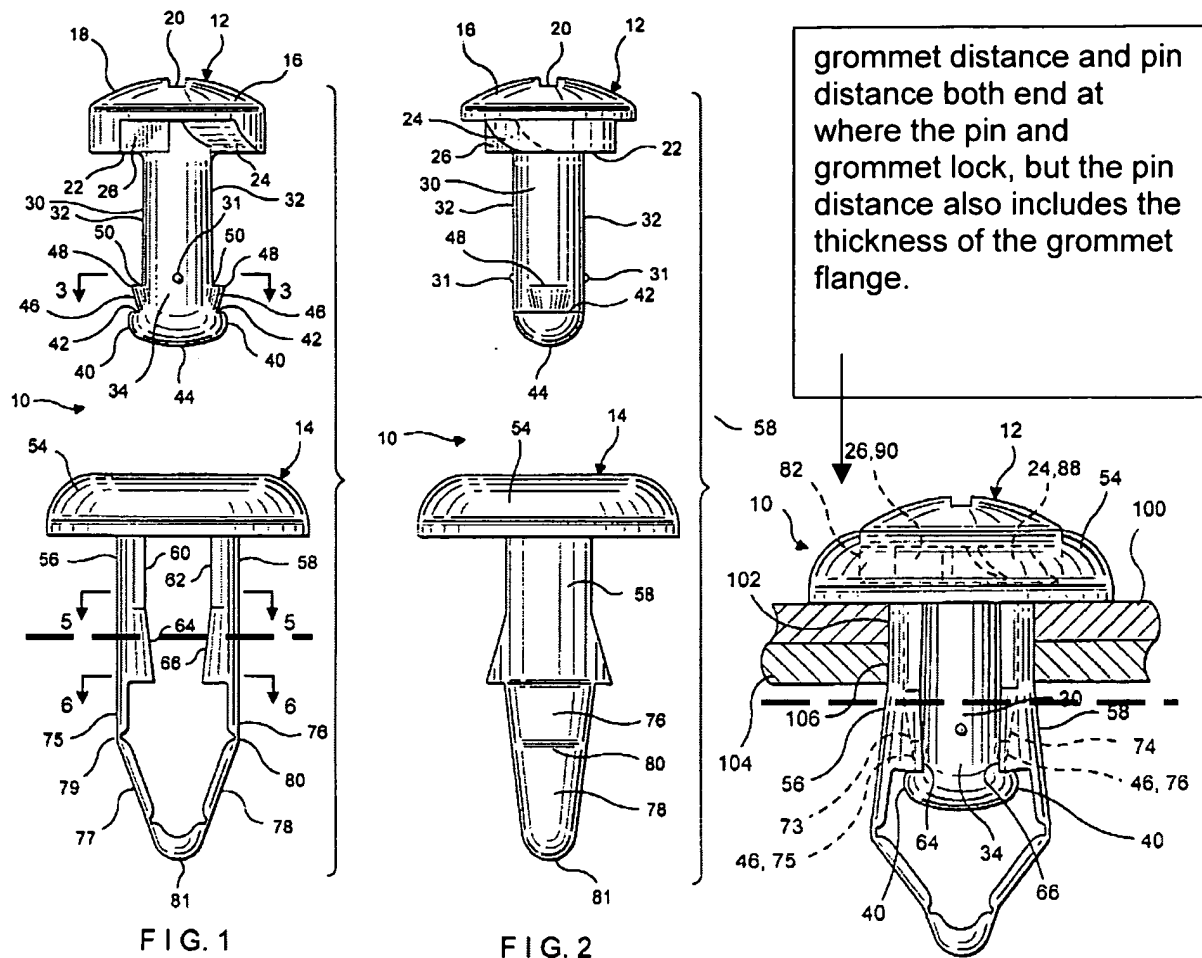


FIG. 1

FIG. 2

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 15-16 rejected under 35 U.S.C. 103(a) as being unpatentable over LeVey or Arisaka.

Examiner takes Official Notice that a groove for insertion tools extending on a

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flange of a fastener is well known. LeVey shows a plurality of such grooves on the pinhead in Fig 7. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of LeVey or Arisaka before him at the time the invention was made, to modify either LeVey or Arisaka to include tool insertion grooves on the flange of the grommet, in order to obtain easy insertion and orientation of the jointing member. One would have been motivated to make such a combination because such grooves for tools are old and well known, and widely accepted and used in the fastener art.

Allowable Subject Matter

6. Examiner is withholding an opinion on the allowability of claims 17-20 until they can be clarified and reconciled with the specification and drawings.

7. Claims 9-11 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action. In particular, examiner notes that there is no art teaching a pin shaft with a lock surface and an engagement surface each engaging an engagement portion of a grommet, in combination with the other claimed limitations, and examiner cannot find it obvious as she does not see how a lock surface and an engagement surface (of a pin) can each be engaging an engagement portion of a grommet when the pin is not inserted in the grommet.

Response to Amendment

8. Applicant requested that examiner call if the case was not in condition for allowance. However, the numerous 112 problems prevent any resolution over the phone so no call was made.

Response to Arguments

9. Applicant's arguments filed 9/29/2005 with respect to all claims have been considered but are moot in view of the new ground(s) of rejection.

10. Applicant's arguments filed 9/29/2005 have been fully considered but they are not persuasive with respect to the 112 rejections above. Several examiners have reviewed and agree the claims as cited above are unclear and confusing.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

13. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to

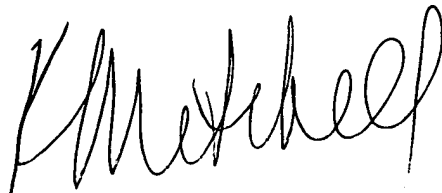
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Katherine W. Mitchell whose telephone number is 571-272-7069. The examiner can normally be reached on Mon - Thurs 10 AM - 8 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Katherine W Mitchell
Primary Examiner
Art Unit 3677

A handwritten signature in black ink, appearing to read 'K Mitchell', written in a cursive style.

Kwm
12/9/2005